

## REMARKS/ARGUMENTS

### **Summary of the Examiner's Actions**

The examiner rejected Claims 11-20 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Applicant acknowledges the rejection under 35 U.S.C. § 112, second paragraph.

The examiner rejected Claims 17-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Letters Patent No. Des. 369,607 ("the '607 patent"), issued to MacGilvary, in view of U.S. Letters Patent No. 4,901,852 ("the '852 patent"), issued to King. Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The examiner rejected Claim 20 under 35 U.S.C. § 103(a) as being unpatentable over the '607 patent, in view of the '852 patent, and further in view of U.S. Letters Patent No. 6,224,543 (the '543 patent"), issued to Gammons *et al.* Applicant acknowledges the rejection under 35 U.S.C. § 103(a).

The examiner allowed Claims 1-10. Applicant appreciates such indication.

The examiner indicated that Claims 11-16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph. Applicant appreciates such indication.

### **Rejections under 35 U.S.C. § 112, second paragraph**

The examiner rejected Claims 11-20 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention.

With respect to Claim 11, the examiner indicated that there is insufficient antecedent basis for the limitation "said second shoulder curved transition" in line 21.

Claim 11 has been amended as indicated above to read -- said second shoulder uninterrupted transition-- in accordance with the previous amendment to the claims. It is respectfully submitted that such amendment overcomes the examiner's rejection. Without further rejection of or objection to Claim 11, it is respectfully submitted that Claim 11 is in condition for allowance.

With respect to Claims 12-16, the examiner indicated that such claims are dependent from Claim 11 and are rejected for the reasons stated above. Claim 13 has also been amended to change "curved" to read --uninterrupted-. Accordingly, based on the amendment to Claim 11, it is respectfully submitted that the examiner's rejection of Claims 12-16 has also been overcome and that Claims 12-16 are likewise in condition for allowance.

With respect to Claims 17-20, the examiner indicated that there is insufficient antecedent basis for the limitation "respective linear side portions" in Claim 17. The examiner further indicated that there is insufficient antecedent basis for the limitation "said carrier" in Claim 19, at line 5. Claims 17-20 have been cancelled without prejudice. Accordingly, it is respectfully submitted that the examiner's rejections with respect to Claims 17-20 is now moot.

#### **Rejections under 35 U.S.C. § 103(a)**

##### **1.       *The Law of Obviousness***

35 U.S.C. §103(a) reads:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. §103(a) (2004).

A rejection under 35 U.S.C. § 103(a) must be supported by a *prima facie* case of obviousness. MPEP § 2142. Section 2143 of the Manual of Patent Examining Procedure summarizes the standards for a *prima facie* case of obviousness under 35 U.S.C. §103. The first element is that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.” MPEP § 2143. The second element is that “there must be a reasonable expectation of success.” *Id.* The third element is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *Id.* The expectation of success and the motivation to combine the references “must both be found in the prior art, not in the applicants disclosure.” *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper); *see* MPEP § 2143.01. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

The standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA). *See In re Gartside*, 203 F.3d

1305,1315,53 U.S.P.Q.2d 1769,1775 (Fed. Cir. 2000); *see also* MPEP 2144.03, pg. 2100-136, 8th ed., rev. 2. There must be some form of evidence in the record to support an assertion of common knowledge. *See In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001); *see also* MPEP 2144.03, pg. 2100-137, 8th ed., rev. 2. "With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." *In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001).

The United States Supreme Court has held that the relevant facts for finding obviousness relate to (1) the scope and content of the prior art, (2) the level of ordinary skill in the field of the invention, (3) the differences between the claimed invention and the prior art, and (4) any objective evidence of nonobviousness such as long felt need, commercial success, the failure of others, or copying. *Graham v. John Deere Co.* 148 U.S.P.Q. 459, 467 (U.S. 1966). The *Graham* Court stated that "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Id.* at 467. The *Graham* court further stated that "[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy." *Id.*

2. *Claims 17-20*

Examiner's Rejection

The examiner rejected Claims 17-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Letters Patent No. Des. 369,607 ("the '607 patent"), issued to

MacGilvary, in view of U.S. Letters Patent No. 4,901,852 ("the '852 patent"), issued to King. The examiner rejected Claim 20 under 35 U.S.C. § 103(a) as being unpatentable over the '607 patent, in view of the '852 patent, and further in view of U.S. Letters Patent No. 6,224,543 (the '543 patent"), issued to Gammons *et al.*

#### Applicant's Argument

While the Applicant respectfully submits that the prior art of record fails to either anticipate or make obvious the invention embodied in Claims 17-20 of the present application, such claims have been cancelled without prejudice in order to expeditiously move those claims indicated as allowable to issuance. Applicant reserves his right to prosecute Claims 17-20 and any other patentable subject matter of the present application not embodied in the allowed claims in a divisional application.

In view of the cancellation of Claims 17-20, it is respectfully submitted that the examiner's rejections under 35 U.S.C. § 103(a) have been made moot.

#### **Claim Objections**

Claims 11-16 have been rewritten as indicated above in order to overcome the examiner's stated rejections under 35 U.S.C. § 112, second paragraph. Applicant respectfully submits that Claims 11-16 are in condition for allowance. Accordingly, the objection of the examiner has been traversed.

#### **Summary**

In view of the amendment of Claims 11-13 and the cancellation of Claims 17-20, without prejudice, and the arguments presented herein, it is believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the examiner is respectfully requested. If, however, the examiner is of the opinion that any of the drawings or other portions of the application are still not

allowable, it will be appreciated if the examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910.

Respectfully submitted,

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